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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,764	09/30/2003	Hoa Duc Nguyen		6271

7590 06/20/2007  
HIGH STANDARD PRODUCTS CORPORATION  
SUITE 225  
14441 BEACH BLVD.  
WESTMINSTER, CA 92683

EXAMINER
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GAKH, YELENA G

ART UNIT	PAPER NUMBER
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1743

MAIL DATE	DELIVERY MODE
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06/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/675,764

Applicant(s)

NGUYEN ET AL.

Examiner

Yelena G. Gakh, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05/03/07.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5, 6, 8, 9 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 2, 5, 6, 8, 9, 11-24 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Election of species with traverse and amendment to the claims and the specification, filed on 05/03/07, are acknowledged. It appears that the Applicants did not fully respond to the prior Office action because of the following omission(s) or matter(s): the species indicated in the Office action did not relate to different carboxylic acids, but rather to different reagents with which the carboxylic acids react. In the present Office action the examiner issues new restriction requirements to the amended claims to which the Applicants should respond with election of **indicated** species.

In response to the restriction of the species directed to different carboxylic acids, which in fact were not indicated in the previous Office action, but which are restricted in the present Office action, the examiner would like to mention that the class of carboxylic acids and esters is one of the largest classes of organic compounds, with aromatic, aliphatic, acyclic, cyclic, heterocyclic, etc. carboxylic acids having totally different properties and reactivity even in the reaction of esterification. Each of the subclasses will require a separate search for the examiner, since the reaction of esterification is a part of the claimed method with different reaction conditions.

2. Examiner's Note: the specification cannot be amended due to election of species. The Applicants should provide the basis for their amendment to the specification and indicate why the amendment does not introduce a new matter.

3. Formal matters. The examiner respectfully requests the Applicants to follow the new rules for amending the claims – the inserted subject matter should be underlined, which is done correctly, while the deleted subject matter should be strikethrough, rather than placed in the square brackets, which makes reading the amended claims difficult. Also, the examiner requests the Applicants not to type in the recitation for the cancelled claims.

#### *Election/Restrictions*

4. A. This application contains claims directed to the following patentably distinct species: carboxylic acids  $R_1\text{COOH}$ , wherein  $R_1$  is alkyl, aryl, or heteroatoms, or containing cyclic or non-cyclic group (claim 1). The species are independent or distinct because these are

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patentably distinct carboxylic acids belonging to different subclasses and having different properties and reactivity toward different reagents.

B. This application contains claims directed to the following patentably distinct species: chloroformate and a stable isotope labeled alcohol (claims 5, 6, 11, 14, 21); and a base and a labeled alkyl halide (claims 7, 8, 12, 15, 23,24). The species are independent or distinct because the reagents are patentably distinct and require different search.

C. This application contains claims directed to the following patentably distinct species: the base is sodium hydroxide, sodium carbonate, pyridine and triethylamine (claims 13 and 23). The species are independent or distinct because these bases are patentably distinct, have different reactivity toward different carboxylic acids, and require different search.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. A telephone call was made to Hoa D. Nguyen on 06/13/07 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and

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specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.


Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

6/13/07

  
**YELENA GAKH**  
**PRIMARY EXAMINER**